

REMARKS

Claim 14 is amended herein to correct claim dependency. No new matter is added.

The Examiner rejected claims 1-7 and 9-10 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 1 recites a method of doing business by a restaurant, wherein a reduced-portion meal is provided and sold for the cost of a full-portion meal, with the excess funds contributed to a charity by the restaurant on behalf of the customer. It is beyond question that methods of doing business are statutory subject matter. *State Street Bank & Trust Co. v. Signature Fin. Group Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998) (“We take this opportunity to lay this ill-conceived [business method] exception to rest.”).

The Examiner provided a two-part test for determining patentability, without citation to the MPEP or any controlling legal authority. Furthermore, the Examiner provided no definition of “technological arts.” The Examiner stated that claims 1-7 and 9-10 only recite an abstract idea. MPEP § 2106(II)(A) states the test for an abstract idea (in the context of computer-related inventions):

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. ... Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.

(emphasis added) Claim 1 is not directed “solely to an abstract idea.” Claim 1 generally addresses two abstract ideas: healthful eating and charitable giving. However, claim 1 recites specific, concrete method steps that implement a practical, real-world process for achieving both abstract ideas. Claim 1 recites a reduced-portion meal having a base price and a full-portion meal having a base price plus excess amount. There is nothing abstract about either product. Claim 1 recites specific, concrete, well-defined method steps of selling the reduced-portion meal at the full-portion meal price, and transferring the excess amount of funds to a charity on behalf of the customer. Items of commerce and specifically articulated methods of

pricing and selling them are certainly within the “technological arts,” as thousands of issued U.S. patents attest.

The Examiner’s statement that “all of the recited steps can be performed in the mind of the user or by use of a pencil and paper” is nonsensical. Claim 1 recites “selling a reduced-portion meal product to a customer.” How is a commercial sales transaction performed in one’s mind? Similarly, claim 1 recites collecting funds from a customer, and transferring funds to a charity. Far from mental exercises, these are actual, real-world, physical process steps, requiring, at a minimum, cash money or a negotiable instrument (or an electronic representation of either) changing hands not once, but a minimum of twice (e.g., the collection of funds from a customer and the transfer of funds to a charity). Neither can commercial transactions nor monetary funds transfers be performed with pencil and paper.¹

The Examiner correctly stated claim 1 produces a useful result. As a concrete process that produces useful results, claim 1 is statutorily patentable subject matter under 35 U.S.C. § 101.

The Examiner rejected claims 1 and 11 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,724,518 to Helbling. Helbling discloses a method of inducing a customer to make a charitable donation by providing him or her with a free beverage as a reward for the donation, at the expense of the restaurant. “[T]he establishment awarding the patron a free beverage...” col. 2, lines 5-12. “The patron, in consideration of the charitable contribution made, is in turn awarded a token...” col. 2, lines 60-61. “[T]he number of beverages to be dispensed as the reward by the service establishment for the contribution level made.” col. 4, lines 44-46. “Thus any patron availing him or himself of the opportunity to make a contribution, not only can benefit from the free food service item...” col. 5, lines 8-10. “[P]atrons benefit from

¹ Which has never been a test of patentability. The hub and spoke financial services data processing of State Street could be performed by pencil and paper, as can virtually any process implemented in software.

the largess of the food-service establishment in making beverages available free of charge to contributors." col. 5, lines 37-39.

Helbling clearly sells customers a full meal at full price, and offers customers the inducement of a free beverage if they make a minimum charitable donation. According to Helbling, the charity-contributing customer receives a tangible benefit – a free beverage – that is paid for by the restaurant. That is, the restaurant must contribute at least the cost of the beverage to make the charity contribution scheme workable. According to the invention of claims 1 and 11, customers' contributions are purely altruistic (or, at the most, motivated by concern for their own good health), and the restaurant does not (necessarily) contribute anything.

Helbling does not disclose selling a customer a reduced-portion meal. The Examiner stated that Helbling discloses selling a reduced portion meal product comprising a meal without a beverage. Helbling discloses no such thing. A customer may purchase a beverage, make a charitable donation, and keep the resulting free drink token to redeem at another time. Alternatively, a customer may purchase a beverage, make a charitable donation, and give the free drink to a companion. Nothing in Helbling defines a "meal" as including a beverage, or that a customer accepting a free beverage has purchased a reduced-portion meal.

Even considering the Examiner's contention *arguendo*, Helbling does not disclose selling a customer a reduced-portion meal, as that term is explicitly defined in Applicant's written description. "Each reduced-portion meal product comprises the same elements as its corresponding full-portion meal product, but in reduced quantities." p. 4, lines 22-24. There is no question that a patent applicant may be his own lexicographer. Where clearly defined, claim terms must be examined with the meaning Applicant gives them. MPEP § 2111.01(III). A reduced-portion meal comprises the same elements as a full-portion meal, but in reduced quantities. Helbling does not disclose or suggest selling a customer a reduced quantity beverage, and then providing him with a free beverage, if he makes a charitable donation.

Furthermore, it is clear from claims 1 and 11 that the method does not (necessarily) cost the restaurant anything. This is important to ensure wide acceptance and implementation. The restaurant collects, for a reduced-portion meal, an amount of funds corresponding to a full-portion meal. These funds include an excess amount over the base price of the reduced-portion meal. The restaurant transfers at least part of the funds to the charity on behalf of the customer. It is readily apparent to those of skill in the art that the restaurant need not offer any inducement for which it must absorb the cost (or, indeed, forego a profit). The price structure of claims 1 and 11 is critical to the widespread acceptance of the methodology by many restaurants nationwide, and is a novel and nonobvious part of Applicant's invention.

The Examiner stated that it would have been obvious to modify Helbling to make the minimum donation amount equal the beverage price. This would remove the key incentive Helbling offers for making a charitable donation: a free beverage. Helbling suggests a minimum donation of \$0.25. col. 4, line 27. Helbling explains that a low minimum donation amount, relative to the price of a beverage, is the key incentive for customer participation: "As a consequence [of Helbling's system], ... patrons benefit from the largess of the food-service establishment in making beverages available free of charge to contributors and thus are induced to contribute to a greater extent than they otherwise might." Col 5, lines 31-40. Making the minimum donation amount equal to the price of the beverage would eliminate all incentive for customer participation – the customer would not be getting anything free, which is the entire key to Helbling. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP § 2143.01.

For at least the reasons that Helbling does not disclose selling a reduced-portion meal for the price of a full-portion meal, and that there exists no motivation to modify Helbling in a manner that would remove the incentive central to Helbling's operation, the Examiner has failed

to establish a prima facie case of obviousness. Accordingly, claims 1 and 11, and all claims depending therefrom, define patentably over the art of record. Prompt allowance of all pending claims is therefore respectfully requested.

Respectfully submitted,

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